



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,881	12/03/2004	Kazuyuki Nako	0033-0964PUSI	1659

2292 7590 12/28/2006
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

DWIVEDI, MAHESH H

ART UNIT	PAPER NUMBER
----------	--------------

2168

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	12/28/2006	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 12/28/2006.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/516,881	Applicant(s) NAKO, KAZUYUKI	
	Examiner Mahesh H. Dwivedi	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Response to Amendment

2. Receipt of Applicant's Amendment, filed on 12/11/2006, is acknowledged. The amendment includes the submission of a new specification and abstract, the addition of claims 9-12, and the amending of claims 1, and 6-8.

Claim Objections

3. The objections raised in the office action mailed 08/10/2006 have been overcome by applicant's amendments received on 12/11/06.

Specification

4. Receipt of Applicant's substitute specification filed on 12/11/06 is acknowledged. Accordingly, the substitute specification is accepted by the examiner for the instant application.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hyon** (U.S. PG PUB 2002/0077135) and in view of **Baker** (U.S. Patent 6,546,417).

7. Regarding claim 1, **Hyon** teaches a display device comprising:

A) a first storage portion for storing beforehand a character code for specifying each character in said text and character shape data corresponding to said character code in a correlated manner (Hyon, Paragraphs 41-42, Figure 4);

B) a second storage portion for storing an image code for specifying said registered image and registered image data corresponding to said image code in a correlated manner according to registration processing by a user (Hyon, Paragraphs 25 and 44, Figure 2);

C) the image code being not stored in the second storage portion beforehand and stored externally by a user (Paragraph 44);

D) a display output portion for outputting said text and said registered image (Hyon, Paragraph 21, Figure 2); and

E) a display control portion for causing said display output portion to output corresponding said text and said registered image based on display data containing a series of said character code, text attribute data, and said image code (Hyon, Paragraphs 21 and 42);

The examiner notes that **Hyon** teaches “a first storage portion for storing beforehand a character code for specifying each character in said text and

Art Unit: 2168

character shape data corresponding to said character code in a correlated manner” as “the user can input a text including typical characters, special characters, or emoticons within the range of a transmittable SMS message, by changing input modes” (Paragraph 41). The examiner further notes that Hyon teaches “**a second storage portion for storing an image code for specifying said registered image and registered image data corresponding to said image code in a correlated manner according to registration processing by a user**” as “storage 18 stores oriental or occidental emoticons according to the cultural area of a user” (Paragraph 25). The examiner further notes that Hyon teaches “**the image code being not stored in the second storage portion beforehand and stored externally by a user**” as “In another embodiment, the user can add hieroglyphics to basic emoticons stored by a manufacturer. The hieroglyphics can be stored in three ways: the user directly stores them, receives them from a base station, and the stores them, or downloads them from the Internet” (Paragraph 44). The examiner further notes that Hyon teaches “**a display output portion for outputting said text and said registered image**” as “a display 16 outputs display data and text messages generated in the mobile terminal. An LCD (Liquid Crystal Display) can be used as the display 16” (Paragraph 21). The examiner further notes that Hyon teaches “**a display control portion (10) for causing said display output portion to output corresponding said text and said registered image based on display data containing a series of said character code, text attribute data, and said image code**” as “a display 16 outputs display data and text messages generated in the mobile terminal. An LCD (Liquid Crystal Display) can be

Art Unit: 2168

used as the display 16" (Paragraph 21) and "After an intended text is completed, the user instructs the mobile terminal to transmit the SMS message including the emoticon...the mobile terminal transmits the stored message" (Paragraph 42). The examiner further notes that it is common knowledge that when text messages are received via a device, the entire message is displayed at once.

Hyon does not explicitly teach:

F) said display control portion having image transforming means for transforming said registered image to be displayed according to said text attribute data.

Baker, however, teaches "**said display control portion having image transforming means for transforming said registered image to be displayed according to said text attribute data**" as "in order to accommodate the use of different size fonts in the mailbox display, means for scaling the size of the icon graphics are also provided...at least one image for each icon is stored, the icon most closely matching the point size of the font is chosen and then scaled as needed to better match the font point size" (Column 8, lines 26-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Baker's** would have allowed **Hyon's** to provide a method for allowing for scalable icons to accompany texts with specified and varied fonts in order to easily associate an icon to a particular sentence, as noted by **Baker** (Column 5, lines 40-55).

Regarding claim 2, **Hyon** does not explicitly teach a display device comprising:

Art Unit: 2168

A) wherein said text attribute data contains size attribute data indicating a character size of the corresponding text (Baker, Column 8, lines 26-40); and

B) said image transforming means scales up/down said registered image according to said size attribute data (Baker, Column 8, lines 26-40).

Baker, however, teaches “**wherein said text attribute data contains size attribute data indicating a character size of the corresponding text**” as “in order to accommodate the use of different size fonts in the mailbox display, means for scaling the size of the icon graphics are also provided...at least one image for each icon is stored, the icon most closely matching the point size of the font is chosen and then scaled as needed to better match the font point size” (Column 8, lines 26-40) and “**said image transforming means scales up/down said registered image according to said size attribute data**” as “in order to accommodate the use of different size fonts in the mailbox display, means for scaling the size of the icon graphics are also provided...at least one image for each icon is stored, the icon most closely matching the point size of the font is chosen and then scaled as needed to better match the font point size” (Column 8, lines 26-40)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Baker’s** would have allowed **Hyon’s** to provide a method for allowing for scalable icons to accompany texts with specified and varied fonts in order to easily associate an icon to a particular sentence, as noted by **Baker** (Column 5, lines 40-55).

Regarding claim 6, **Hyon** teaches a method comprising:

A) storing an image code for specifying said registered image and registered image data corresponding to said image code in a correlated manner according to registration processing by a user (Hyon, Paragraphs 25 and 44, Figure 2);

B) the image code being not stored in the second storage portion beforehand and stored externally by a user (Paragraph 44); and

C) displaying said text and said registered image simultaneously based on said transformed registered image, and said text attribute data and the character code for specifying each character in said text, and character shape data corresponding to said character code stored beforehand in a correlated manner (Hyon, Paragraphs 21 and 42).

The examiner notes that **Hyon** teaches “**storing an image code for specifying said registered image and registered image data corresponding to said image code in a correlated manner according to registration processing by a user**” as “storage 18 stores oriental or occidental emoticons according to the cultural area of a user” (Paragraph 25). The examiner further notes that **Hyon** teaches “**the image code being not stored in the second storage portion beforehand and stored externally by a user**” as “In another embodiment, the user can add hieroglyphics to basic emoticons stored by a manufacturer. The hieroglyphics can be stored in three ways: the user directly stores them, receives them from a base station, and the stores them, or downloads them from the Internet” (Paragraph 44). The examiner further notes that **Hyon** teaches “**displaying said text and said registered image simultaneously**

Art Unit: 2168

based on said transformed registered image, and said text attribute data and the character code for specifying each character in said text, and character shape data corresponding to said character code stored beforehand in a correlated manner” as “a display 16 outputs display data and text messages generated in the mobile terminal. An LCD (Liquid Crystal Display) can be used as the display 16” (Paragraph 21) and “After an intended text is completed, the user instructs the mobile terminal to transmit the SMS message including the emoticon...the mobile terminal transmits the stored message” (Paragraph 42). The examiner further notes that it is common knowledge that when text messages are received via a device, the entire message is displayed at once.

Hyon does not explicitly teach:

D) with respect to display data containing a series of a character code, text attribute data, and said image code, transforming said registered image to be displayed according to said text attribute data.

Baker, however, teaches “**with respect to display data containing a series of a character code, text attribute data, and said image code, transforming said registered image to be displayed according to said text attribute data**” as “in order to accommodate the use of different size fonts in the mailbox display, means for scaling the size of the icon graphics are also provided...at least one image for each icon is stored, the icon most closely matching the point size of the font is chosen and then scaled as needed to better match the font point size” (Column 8, lines 26-40).

Art Unit: 2168

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Baker's** would have allowed **Hyon's** to provide a method for allowing for scalable icons to accompany texts with specified and varied fonts in order to easily associate an icon to a particular sentence, as noted by **Baker** (Column 5, lines 40-55).

Regarding claim 7, **Hyon** teaches a viewer program comprising:

- A) storing an image code for specifying said registered image and registered image data corresponding to said image code in a correlated manner according to registration processing by a user (Hyon, Paragraphs 25 and 44, Figure 2);
- B) the image code being not stored in the second storage portion beforehand and stored externally by a user (Paragraph 44); and
- C) displaying said text and said registered image simultaneously based on said transformed registered image, and said text attribute data and the character code for specifying each character in said text, and character shape data corresponding to said character code stored beforehand in a correlated manner (Hyon, Paragraphs 21 and 42).

The examiner notes that **Hyon** teaches “**storing an image code for specifying said registered image and registered image data corresponding to said image code in a correlated manner according to registration processing by a user**” as “storage 18 stores oriental or occidental emoticons according to the cultural area of a user” (Paragraph 25). The examiner further notes that **Hyon** teaches “the image code

being not stored in the second storage portion beforehand and stored externally

by a user" as "In another embodiment, the user can add hieroglyphics to basic emoticons stored by a manufacturer. The hieroglyphics can be stored in three ways: the user directly stores them, receives them from a base station, and the stores them, or downloads them from the Internet" (Paragraph 44). The examiner further notes that **Hyon teaches "displaying said text and said registered image simultaneously based on said transformed registered image, and said text attribute data and the character code for specifying each character in said text, and character shape data corresponding to said character code stored beforehand in a correlated manner"** as "a display 16 outputs display data and text messages generated in the mobile terminal. An LCD (Liquid Crystal Display) can be used as the display 16" (Paragraph 21) and "After an intended text is completed, the user instructs the mobile terminal to transmit the SMS message including the emoticon...the mobile terminal transmits the stored message" (Paragraph 42). The examiner further notes that it is common knowledge that when text messages are received via a device, the entire message is displayed at once.

Hyon does not explicitly teach:

D) with respect to display data containing a series of a character code, text attribute data, and said image code, transforming said registered image to be displayed according to said text attribute data.

Baker, however, teaches "**with respect to display data containing a series of a character code, text attribute data, and said image code, transforming said**

Art Unit: 2168

registered image to be displayed according to said text attribute data" as "in order to accommodate the use of different size fonts in the mailbox display, means for scaling the size of the icon graphics are also provided...at least one image for each icon is stored, the icon most closely matching the point size of the font is chosen and then scaled as needed to better match the font point size" (Column 8, lines 26-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Baker's** would have allowed **Hyon's** to provide a method for allowing for scalable icons to accompany texts with specified and varied fonts in order to easily associate an icon to a particular sentence, as noted by **Baker** (Column 5, lines 40-55).

Regarding claim 8, **Hyon** teaches a computer readable recording medium comprising:

- A) storing an image code for specifying said registered image and registered image data corresponding to said image code in a correlated manner according to registration processing by a user (Hyon, Paragraphs 25 and 44, Figure 2);
- B) the image code being not stored in the second storage portion beforehand and stored externally by a user (Paragraph 44); and
- C) displaying said text and said registered image simultaneously based on said transformed registered image, and said text attribute data and the character code for specifying each character in said text, and character shape data corresponding to said

Art Unit: 2168

character code stored beforehand in a correlated manner (Hyon, Paragraphs 21 and 42).

The examiner notes that Hyon teaches **“storing an image code for specifying said registered image and registered image data corresponding to said image code in a correlated manner according to registration processing by a user”** as “storage 18 stores oriental or occidental emoticons according to the cultural area of a user” (Paragraph 25). The examiner further notes that Hyon teaches **“the image code being not stored in the second storage portion beforehand and stored externally by a user”** as “In another embodiment, the user can add hieroglyphics to basic emoticons stored by a manufacturer. The hieroglyphics can be stored in three ways: the user directly stores them, receives them from a base station, and the stores them, or downloads them from the Internet” (Paragraph 44). The examiner further notes that Hyon teaches **“displaying said text and said registered image simultaneously based on said transformed registered image, and said text attribute data and the character code for specifying each character in said text, and character shape data corresponding to said character code stored beforehand in a correlated manner”** as “a display 16 outputs display data and text messages generated in the mobile terminal. An LCD (Liquid Crystal Display) can be used as the display 16” (Paragraph 21) and “After an intended text is completed, the user instructs the mobile terminal to transmit the SMS message including the emoticon...the mobile terminal transmits the stored message” (Paragraph 42). The examiner further notes that it is

Art Unit: 2168

common knowledge that when text messages are received via a device, the entire message is displayed at once.

Hyon does not explicitly teach:

D) with respect to display data containing a series of a character code, text attribute data, and said image code, transforming said registered image to be displayed according to said text attribute data.

Baker, however, teaches “**with respect to display data containing a series of a character code, text attribute data, and said image code, transforming said registered image to be displayed according to said text attribute data**” as “in order to accommodate the use of different size fonts in the mailbox display, means for scaling the size of the icon graphics are also provided...at least one image for each icon is stored, the icon most closely matching the point size of the font is chosen and then scaled as needed to better match the font point size” (Column 8, lines 26-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Baker's** would have allowed **Hyon's** to provide a method for allowing for scalable icons to accompany texts with specified and varied fonts in order to easily associate an icon to a particular sentence, as noted by **Baker** (Column 5, lines 40-55).

8. Claims 3-5, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hyon** (U.S. PG PUB 2002/0077135) and in view of **Baker** (U.S. Patent 6,546,417)

Art Unit: 2168

as applied to claims 1-2, and 6-8 and further in view of **Ostermann et al.** (U.S. Patent 6,990,452).

9. Regarding claim 3, **Hyon** and **Baker** do not explicitly teach a display device comprising:

- A) wherein said text attribute data contains color attribute data indicating at least a fore color of a corresponding text; and
- B) said image transforming means converts a color of said registered image according to said color attribute data.

Ostermann, however, teaches **“wherein said text attribute data contains color attribute data indicating at least a fore color of a corresponding text”** as “The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means. For example, the method may comprise providing the sender an option to assign a color to the at least typed one word such that the chosen emoticon begins to be presented by the animated entity to the recipient at the first typed word with the assigned color and the chosen emoticon presentation by the animated entity ends at the last typed word with the assigned color” (Column 11, lines 43-50) and **“said image transforming means converts a color of said registered image according to said color attribute data”** as “The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means. For example, the method may comprise providing the sender an option to assign a color to the at least typed one word such that the chosen emoticon begins to be presented by

Art Unit: 2168

the animated entity to the recipient at the first typed word with the assigned color and the chosen emoticon presentation by the animated entity ends at the last typed word with the assigned color" (Column 11, lines 43-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Ostermann's** would have allowed **Hyon's** and **Baker's** to provide a method to allow the ability to insert a customized emoticon or specified image by a single button click, as noted by **Ostermann** (Column 3, lines 35-54).

Regarding claim 4, **Hyon** and **Baker** do not explicitly teach a display device comprising:

A) wherein said registered is a gray image, said image transforming means converts each pixel into a color made by mixing the fore color and a back color of said text at a ratio according to a pixel value.

Ostermann, however, teaches "**wherein said registered is a gray image, said image transforming means converts each pixel into a color made by mixing the fore color and a back color of said text at a ratio according to a pixel value**" as "The increased intensity of the emoticon may be accomplished by changing the icon from black-on-white background to black-on-colored background (such as red or yellow) where the intensity of the background color reflects the amplitude" (Column 9, lines 43-67) and "The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means. For example, the method may comprise

Art Unit: 2168

providing the sender an option to assign a color to the at least typed one word such that the chosen emoticon begins to be presented by the animated entity to the recipient at the first typed word with the assigned color and the chosen emoticon presentation by the animated entity ends at the last typed word with the assigned color" (Column 11, lines 43-50)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Ostermann's** would have allowed **Hyon's** and **Baker's** to provide a method to allow the ability to insert a customized emoticon or specified image by a single button click, as noted by **Ostermann** (Column 3, lines 35-54).

Regarding claim 5, **Hyon** and **Baker** do not explicitly teach a display device comprising:

- A) wherein said text attribute data contains decoration attribute data indicating a type of a decoration applied to a corresponding text; and
- B) said image transforming means decorates said registered image according to said decoration attribute data.

Ostermann, however, teaches "**wherein said text attribute data contains decoration attribute data indicating a type of a decoration applied to a corresponding text**" as "The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means...In this case, in a sentence such as "Hi John, :-) are you pleased that the stock market is up?" the underlining

Art Unit: 2168

represents the highlighting wherein the sender chooses to begin the smile at the beginning of the word "are" and to continue the smile through the word "up". The method comprises receiving the indicated duration of the emoticon and presenting the chosen duration of the emoticon" (Column 11, lines 43-61) and **"said image transforming means decorates said registered image according to said decoration attribute data"** as "The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means...In this case, in a sentence such as "Hi John, :-) are you pleased that the stock market is up?" the underlining represents the highlighting wherein the sender chooses to begin the smile at the beginning of the word "are" and to continue the smile through the word "up". The method comprises receiving the indicated duration of the emoticon and presenting the chosen duration of the emoticon" (Column 11, lines 43-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Ostermann's** would have allowed **Hyon's** and **Baker's** to provide a method to allow the ability to insert a customized emoticon or specified image by a single button click, as noted by **Ostermann** (Column 3, lines 35-54).

Regarding claim 5, **Hyon** and **Baker** do not explicitly teach a display device comprising:

A) wherein said text attribute data contains decoration attribute data indicating a type of a decoration applied to a corresponding text; and

Art Unit: 2168

B) said image transforming means decorates said registered image according to said decoration attribute data.

Ostermann, however, teaches “**wherein said text attribute data contains decoration attribute data indicating a type of a decoration applied to a corresponding text**” as “The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means...In this case, in a sentence such as “Hi John, ;-) are you pleased that the stock market is up?” the underlining represents the highlighting wherein the sender chooses to begin the smile at the beginning of the word “are” and to continue the smile through the word “up”. The method comprises receiving the indicated duration of the emoticon and presenting the chosen duration of the emoticon” (Column 11, lines 43-61) and “**said image transforming means decorates said registered image according to said decoration attribute data**” as “The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means...In this case, in a sentence such as “Hi John, ;-) are you pleased that the stock market is up?” the underlining represents the highlighting wherein the sender chooses to begin the smile at the beginning of the word “are” and to continue the smile through the word “up”. The method comprises receiving the indicated duration of the emoticon and presenting the chosen duration of the emoticon” (Column 11, lines 43-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching

Ostermann's would have allowed **Hyon's** and **Baker's** to provide a method to allow

Art Unit: 2168

the ability to insert a customized emoticon or specified image by a single button click, as noted by **Ostermann** (Column 3, lines 35-54).

Regarding claim 9, **Hyon** and **Baker** do not explicitly teach a display device comprising:

A) wherein said transforming means includes image decoration means for decorating said registered image to provide continuous decoration to both said registered image and neighboring characters adjacent to said registered image according to said decoration attribute data.

Ostermann, however, teaches “**wherein said transforming means includes image decoration means for decorating said registered image to provide continuous decoration to both said registered image and neighboring characters adjacent to said registered image according to said decoration attribute data**” as “The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means...In this case, in a sentence such as “Hi John, :-)
are you pleased that the stock market is up?” the underlining represents the highlighting wherein the sender chooses to begin the smile at the beginning of the word “are” and to continue the smile through the word “up”. The method comprises receiving the indicated duration of the emoticon and presenting the chosen duration of the emoticon as the animated entity delivers the message. As mentioned above, the highlighting can occur through coloring words, underlining words, or some other means of presenting the emotion” (Column 11, lines 43-61).

Art Unit: 2168

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Ostermann's** would have allowed **Hyon's** and **Baker's** to provide a method to allow the ability to insert a customized emoticon or specified image by a single button click, as noted by **Ostermann** (Column 3, lines 35-54).

Regarding claim 10, **Hyon** and **Baker** do not explicitly teach a display device comprising:

A) wherein said image decoration means decorates said registered image, such that both said registered image and said neighboring characters show the said fore and back colors continuously.

Ostermann, however, teaches “**wherein said image decoration means decorates said registered image, such that both said registered image and said neighboring characters show the said fore and back colors continuously**” as The increased intensity of the emoticon may be accomplished by changing the icon from black-on-white background to black-on-colored background (such as red or yellow) where the intensity of the background color reflects the amplitude” (Column 9, lines 43-67) and “The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means...In this case, in a sentence such as “Hi John; :-) are you pleased that the stock market is up?” the underlining represents the highlighting wherein the sender chooses to begin the smile at the beginning of the word “are” and to continue the smile through the word “up”. The method comprises receiving

Art Unit: 2168

the indicated duration of the emoticon and presenting the chosen duration of the emoticon as the animated entity delivers the message. As mentioned above, the highlighting can occur through coloring words, underlining words, or some other means of presenting the emotion" (Column 11, lines 43-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Ostermann's** would have allowed **Hyon's** and **Baker's** to provide a method to allow the ability to insert a customized emoticon or specified image by a single button click, as noted by **Ostermann** (Column 3, lines 35-54).

Regarding claim 11, **Hyon** and **Baker** do not explicitly teach a display device comprising:

A) wherein said image decoration means decorates said registered image to draw a continuous underline below both said registered image and said neighboring characters.

Ostermann, however, teaches "**wherein said image decoration means decorates said registered image to draw a continuous underline below both said registered image and said neighboring characters**" as "The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means...In this case, in a sentence such as "Hi John, :-) are you pleased that the stock market is up?" the underlining represents the highlighting wherein the sender chooses to begin the smile at the beginning of the word "are" and to continue the smile through the word "up". The method comprises receiving the indicated duration of the emoticon

Art Unit: 2168

and presenting the chosen duration of the emoticon as the animated entity delivers the message. As mentioned above, the highlighting can occur through coloring words, underlining words, or some other means of presenting the emotion" (Column 11, lines 43-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Ostermann's** would have allowed **Hyon's** and **Baker's** to provide a method to allow the ability to insert a customized emoticon or specified image by a single button click, as noted by **Ostermann** (Column 3, lines 35-54).

Regarding claim 12, **Hyon** and **Baker** do not explicitly teach a display device comprising:

A) wherein said image decoration means decorates said registered image to draw a continuous cancel line on both said registered image and said neighboring characters.

Ostermann, however, teaches "**wherein said image decoration means decorates said registered image to draw a continuous cancel line on both said registered image and said neighboring characters**" as "The sender can associate typed words with an emoticon by underlining, coloring, highlighting, or by any other means...In this case, in a sentence such as "Hi John, :-) are you pleased that the stock market is up?" the underlining represents the highlighting wherein the sender chooses to begin the smile at the beginning of the word "are" and to continue the smile through the word "up". The method comprises receiving the indicated duration of the emoticon

Art Unit: 2168

and presenting the chosen duration of the emoticon as the animated entity delivers the message. As mentioned above, the highlighting can occur through coloring words, underlining words, or some other means of presenting the emotion" (Column 11, lines 43-61).

The examiner notes that it is clear that **Ostermann's** method can use various computer font techniques to apply to sentences with emoticons, such as underlines and highlighters.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Ostermann's** would have allowed **Hyon's** and **Baker's** to provide a method to allow the ability to insert a customized emoticon or specified image by a single button click, as noted by **Ostermann** (Column 3, lines 35-54).

Response to Arguments

10. Applicant's arguments filed on 12/11/2006 have been fully considered but they are not persuasive.

Applicant goes on to argue on pages 2-3, that "**Hyon does not state that emotions are not stored in the storage 18 beforehand and are stored externally by a user...Therefore, Hyon fails to disclose or suggest the "second storage portion" as recited in claim 1**". However, the examiner wishes to point to paragraph 44 of **Hyon** which states "In another embodiment, the user can add hieroglyphics to basic emoticons stored by a manufacturer. The hieroglyphics can be stored in three ways: the user directly stores them, receives them from a base station, and the stores them, or

Art Unit: 2168

downloads them from the Internet" (Paragraph 44). The examiner further wishes to state that it is clear that a user can download emoticons to a mobile terminal from external storage (see "internet" and "base station")

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,987,991 by **Nelson** on 17 January 2006. The subject matter disclosed therein is pertinent to that of claims 1-8 (e.g., methods automatically scale graphics into a text sentence that is sent to another user).

U.S. PGPUB 2002/0120653 by **Kraft et al.** on 29 August 2002. The subject matter disclosed therein is pertinent to that of claims 1-8 (e.g., methods automatically scale graphics into a text sentence that is sent to another user).

U.S. Patent 6,584,479 by **Chang et al.** on 24 June 2003. The subject matter disclosed therein is pertinent to that of claims 1-8 (e.g., methods automatically scale graphics into a text sentence that is sent to another user).

U.S. Patent 6,456,305 by **Qureshi et al.** on 24 September 2002. The subject matter disclosed therein is pertinent to that of claims 1-8 (e.g., methods automatically scale graphics into a text sentence that is sent to another user).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mahesh Dwivedi whose telephone number is (571) 272-2731. The examiner can normally be reached on Monday to Friday 8:20 am – 4:40 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached (571) 272-3642. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 2168

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mahesh Dwivedi

Patent Examiner

Art Unit 2168



TIM VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100



December 21, 2006

Leslie Wong 

Primary Examiner